

REMARKS

Claims 1-22 and 24 are currently pending, claim 23 having been cancelled by the present amendment without prejudice or disclaimer and claim 24 having previously been added. Claims 1, 12, 13, 17, and 22 are the only independent claims. Support for the foregoing amendments can be found in, for example, at least paras. 0052, 0054, and 0056 of the patent application publication of the present application. No new matter has been added.

Claims 1-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0212617 to Fitzmaurice et al. in view of U.S. Patent No. 6,618,063 to Kurtenbach et al. Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the pending claims in view of the following arguments.

Allowable Subject Matter

Applicant notes with appreciation that claim 24 was indicated as being allowable if rewritten in independent form. However, at this time, Applicant respectfully declines this invitation in view of the comments presented herein.

Claim Rejections - 35 U.S.C. §103(a)

Claims 1-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fitzmaurice in view of Kurtenbach.

Claim 1 is directed toward a method which includes “enlarging a particular selection of the plurality of selections relative to remaining selections of the plurality of selections responsive to the second end of the first segment being within a general proximity of the particular selection.”

At least in part as an alternative to reliance solely on Kurtenbach, the Office Action indicates that Fitzmaurice teaches a number of claim limitations, except for the “enlarging” element identified above. The Action attempts to remedy this deficiency of Fitzmaurice by relying upon Kurtenbach to teach the enlarging feature. Although the Action has combined Kurtenbach and Fitzmaurice, Applicant asserts that even if one skilled in the art were to combine

the teachings of these references in the manner asserted, the process disclosed by these references would not teach or suggest all of the recited elements of claim 1.

Pages 5 and 6 of the Office Action refer to enlarged tool box 268 of Fig. 13 of Kurtenbach as purportedly teaching the foregoing “enlarging” element of claim 1. Applicant respectfully disagrees.

First of all, in Fig. 13 of Kurtenbach, the enlarged tool box 268 is purportedly the same as the tool box of Fig. 12. The top portion of tool box 268 (Fig. 13) is a marking menu, an example of which appears to be shown in Fig. 6 (marking menu items 62). The bottom portion of tool box 268 (Fig. 13) is described as a linear menu, an example of which is also shown in Fig. 6 (linear menu items 64). Kurtenbach further describes Fig. 6 as an example of a combined tool box, such that these tool boxes have both a marking menu 62 and a linear menu 64.

Applicant’s review of the cited portions of Kurtenbach reveals a discussion relating to the expansion of tool pallet 268. This passage of Kurtenbach is reproduced as follows:

FIG. 13 illustrates icon sets 250-264 of a tool box 266 and the expansion of the tool pallet 268 of a selected one of the tool sets 252 with the pointer being positioned at the center of the pallet when expanded allowing continued marking or location dependent selections from the center of the pallet. This illustrates that the pallet can be expanded from a small and generally hard to decipher icon display representation. In addition, the marking selection process can be used to select icons from the small representations of the icons on the left in this figure even when the icons have not been popped-up or expanded to full size, when they might not be “readable” and when the user would have to remember which icon represented which selection. (Kurtenbach col. 8, lines 17-29) (emphasis added).

Applicant assumes *arguendo* that the expansion of tool pallet 268 and all of the included icons discloses a type of “enlarging” of selections. Even if this were correct, claim 1 remains distinguishable for several reasons. First, the so-called enlarging performed by Fig. 13 of Kurtenbach relates to the expansion of the entire tool pallet 268, including all of the icons (e.g., icons 210-234 of Fig. 12). Kurtenbach therefore at best discloses a scheme for enlarging all of a plurality of selections. This arrangement is quite different than claim 1 which requires

“enlarging a particular selection of the plurality of selections relative to remaining selections of the plurality of selections.” In Fig. 13, none of the icons of tool pallet 268 are enlarged relative to remaining icons of the tool pallet 268.

Another difference is that the alleged enlarging of Fig. 13 occurs by the user selecting a particular tool set 252 to enlarge. Kurtenbach is noticeably silent as to how this selecting operation occurs. The only discussion on this aspect, which is also set out in the passage above, is as follows: “FIG. 13 illustrates icon sets 250-264 of a tool box 266 and the expansion of the tool pallet 268 of a selected one of the tool sets 252.” Kurtenbach is silent as to how the tool set is selected, and thus, is equally silent as to how tool pallet 268 is enlarged. Regardless of how Kurtenbach accomplishes such selection, the fact remains that it does not do it in a manner consistent with claim 1. That is, the so-called “selection” of Kurtenbach does not occur “responsive to the second end of the first segment being within a general proximity of the particular selection,” as required by claim 1.

As an additional point, Applicant recognizes that Kurtenbach describes (as set out above) that a marking selection process can be used to select icons from the small representations of the icons on the left side of Fig. 13, even if the icons have not been expanded such as that shown on the right side of Fig. 14 (i.e., tool pallet 268). Kurtenbach describes two techniques for allowing items to be selected in a marking selection process. (Kurtenbach col. 4, lines 21-23). One technique is shown in Fig. 4 and the other technique is shown in Fig. 5. Applicant emphasizes that these selection techniques only occur, according to Kurtenbach, when the icons have not been expanded. Put another way, the selection techniques of Figs. 4 and 5 have nothing to do with the enlarging of tool pallet 268.

Furthermore, page 14 of the Office Action suggests that tool pallet 268 is enhanced or enlarged compared to icon sets 256 and 258. The Office Action also seems to equate the enhanced tool pallet with the claimed “particular selection,” and icon sets 256 and 258 as teaching the claimed “remaining selections of the plurality of selections.” Applicant assumes *arguendo* that Kurtenbach discloses such features. However, even if this were correct, claim 1 remains distinguishable since the so-called enlarging of tool pallet 268 does not occur “responsive to the second end of the first segment being within a general proximity of the

particular selection” as recited in this claim. Applicant again emphasizes that while Kurtenbach discloses the selection techniques of Figs. 4 and 5, such techniques are simply used to select a particular icon of a tool pallet and are not used for “enlarging a particular selection” as required by claim 1. Kurtenbach is quite clear on this point, as set out in the passage above.

In view of the foregoing, Applicant submits that neither Fitzmaurice nor Kurtenbach teach the identified features recited in claim 1. Therefore, for the reasons presented above, even if one skilled in the art were to combine the teachings of Fitzmaurice and Kurtenbach in the manner asserted, claim 1 would still be patentable since all of the claim limitations have not been taught or reasonably suggested. Since independent claims 12, 13, 17, and 22 have language similar to that of claim 1, these claims are also believed to be patentable for reasons similar to those set out in conjunction with claim 1. Additionally, the pending dependent claims 2-11, 14-16, 18-21, 23, and 24 would be patentable at least by virtue of their respective dependence upon patentable independent claims 1, 13, 17, and 22.

CONCLUSION

By way of this amendment, Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues, it is respectfully requested that the Examiner telephone Thomas F. Lebens at (805) 541-2800 so that such issues may be resolved as expeditiously as possible.

Address all correspondence to:
FITCH, EVEN, TABIN & FLANNERY
120 So. LaSalle Street, Ste. 1600
Chicago, IL 60603

Direct telephone inquiries to:
Thomas F. Lebens
(805) 541-2800
San Luis Obispo, California Office of
FITCH, EVEN, TABIN & FLANNERY

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

/Jeffrey J. Lotspeich/
Jeffrey J. Lotspeich
Attorney for Applicant(s)
Reg. No. 45,737

Date: November 21, 2008